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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,614	04/02/2004	Paul Lapstun	HYG016US	9403
24011 7590 09/29/2009 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA				
			EXAMINER ZHANG, FAN	
			ART UNIT 2625	PAPER NUMBER
			NOTIFICATION DATE 09/29/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/815,614

Applicant(s)

LAPSTUN ET AL.

Examiner

FAN ZHANG

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 11, 14, 17, 20, 27-29, 32-35, 41, and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims **withdrawn** from consideration are 5-7,9,10,12,13,15,16,18,19,21-26,30,31,36-40,42-46 and 48.

DETAILED ACTION

Response to Arguments

1. Applicants' remarks filed on July 24, 2009 have been acknowledged but not found persuasive. Claims 1-4, 8, 11, 14, 17, 20, 27-29, 32-35, 41, and 47 remain rejected; and claims 5-7, 9, 10, 12, 13, 15, 16, 18, 19, 21-26, 30, 31, 36-40, 42-46, and 48 are cancelled.

With respect to claim 1, Applicants argues Examiner has no motivation to combine the teaching of cited references. Examiner respectfully disagrees. MPEP 2143.01 states "There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teaching of the prior art, and the knowledge of persons of ordinary skilled in the art." First of all, the three references from Lubow, Pinchen, and Kurokawa are all in the same field of endeavor since they are all related to indicia/barcode printing for identification purpose. Lubow disclose applying different codes to different batch of products but identical codes to the items from the same batch whereas Pinchen applies a unique code to each individual item. It is obvious that the combined technique would help better verify, locate, and track each individual item without confusion. Further, Kurokawa discloses data of each coded data portion include information regarding the respective positions of each data portion. Since Lubow teaches two barcode portions to be applied to each item in two separate printing processes, it would have been obvious to apply Kurokawa's method to Lubow's labeling so that when trying to obtain information from both barcodes by an automatic scanning machine, the location of the second barcode can be easily identified once the

first barcode is scanned to shorten overall processing time and improve productivity. Therefore, with the explanation above, it would have been obvious for an ordinary skilled in the art to combine prior art elements according to known methods to yield predictable results as suggested by MPEP 2141 & 2143. Examiner has re-stated below the previous rejection for Applicants' convenience.

Response to Amendments

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 4, 11, 14, 17, 27-29, 33, 35, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubow et al (US Pub: US 2006/0118631) and in further view of Pinchen et al (US Patent.: 7,188,774) and Kurokawa (US Patent: 5,625,467).**

Regarding claim 1 (previously presented), Lubow et al teach: A method of printing an interface surface associated with a product item, the method including the steps of: (a) determining product identity data, the product identity data identifies the product such that the product is distinguished from each other product [p0017]; and, (b) controlling a printer to thereby print a plurality of coded data portions on the interface

surface, the data of each coded data portion being indicative of the product identity data [p0086, p0087].

Lubow et al do not specify each product item to be uniquely identified from other product items. In the same field of endeavor, Pinchen et al teach: the product identity data uniquely identifies the product item such that the product item is distinguished from each other product item [col 1: lines 14-21] and controlling a printer to thereby print a plurality of coded data portions on the interface surface, the data of each coded data portion being indicative of the product identity data [col 2: lines 31-67, col 3: lines 1-39]. Uniquely identifying a product item has been well practiced in the art as prescribed by Pinchen et al. Therefore, it would have been obvious for an ordinary skilled in the art to modify Lubow et al's teaching to tag each product item with unique identification for the purpose of easy recognition or identification associated with after market service such as warranty registration or for security purpose.

Lubow et al do not disclose the coded data being indicative of the respective position of the coded data portion on the interface surface. Pinchen et al teach the coded data being indicative of a predetermined location in [col 3: lines 19-22, 36-39]. In the same field of endeavor, Kurokawa teaches: the data of each coded data portion is further indicative of the respective positions of the coded data portions on the interface surface [col 10: lines 46-55, col 13: lines 31-37]. Having a coded data indicative of the respective position of the code has been well practiced in the art as prescribed by Pinchen et al and Kurokawa. Therefore, it would have been obvious for an ordinary skilled in the art to modify Lubow et al's teaching to incorporate the position information

as part of coded data for forming a composite bar code by precisely printing a second code next to a first one whose relative position can be obtained by scanning itself.

Regarding claim 2 (previously presented), the rationale applied to the rejection of claim 1 has been incorporated herein. Lubow et al further teach: the method of claim 1, wherein the determining step includes the sub-steps of: receiving indicating data at least partially indicative of the identity of the product items; and, generating, using the indicating data, the product identity data [p0047].

Regarding claim 4 (previously presented), the rationale applied to the rejection of claim 1 has been incorporated herein. Lubow et al further teach: The method of claim 1, wherein at least one of the product item and the interface surface is associated with a barcode, and the determining step includes sensing the barcode to determine the product identity data [p0087].

Regarding claim 11 (previously presented), the rationale applied to the rejection of claim 1 has been incorporated herein. Pinchen et al further teach: The method of any one of claim 1, wherein the coded data portions are printed in infrared ink [col 13: lines 12-19].

Regarding claim 14 (previously presented), the rationale applied to the

rejection of claim 1 has been incorporated herein. Lubow et al further teach: The method of claim 1, wherein the determining step includes the sub-steps of: determining an identifier indicative of a nature of the product item [p0087: lines 15-17]; generating a serial number [p0087: lines 17-20. A serial number can be a commodity number.]; and forming the product identity data from the identifier and the serial number [p0086: lines 23-32]

Regarding claim 17 (previously presented), the rationale applied to the rejection of claim 1 has been incorporated herein. Lubow et al do not specify an EPC associated with the product item. Since EPC (Electronic Product Code) is a type of application of RFID technology, Pinchen et al further teach: the method of claim 1, wherein the product identity data is indicative of an EPC associated with the product item [col 11: lines 5-12, col 13: lines 65-67].

Claim 27 (previously presented) has been analyzed and rejected w/r to claim 1 in accordance with Lubow et al's further teaching on: a printer for printing an interface surface associated with a product item [fig. 2, unit 145].

Claim 28 (previously presented) has been analyzed and rejected w/r to claim 2 in accordance with the rejection of claim 27 and Lubow et al's further teaching on: a computer system communicates with the printer [fig. 2, unit 120].

Claim 29 (original) has been analyzed and rejected w/r to claim 11 in accordance with the rejection of claim 27.

Regarding claim 33 (original), the rationale applied to the rejection of claim 27 has been incorporated herein. Lubow et al further teach: The printer of claim 27, wherein at least one of the product item and the interface surface is associated with a barcode, the printer being adapted to sense the barcode to determine the product identity data [p0038].

Regarding claim 35 (previously presented), the rationale applied to the rejection of claim 27 has been incorporated herein. Lubow et al further teach: The printer of claim 27, wherein the printer is further adapted to encode the product identity data by printing a barcode on the interface surface or the product item [p0086, p0087].

Claim 47 (previously presented) has been analyzed and rejected w/r to claims 27 and 28.

4. **Claims 3, 8, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubow et al (US Pub: US 2006/0118631), Pinchen et al (US Patent.: 7,188,774) and Kurokawa (US Patent: 5,625,467); and in further view of Klein (US Pub: 2001/0037248).**

Regarding claims 3 and 8 (previously presented), the rationale applied to the

rejection of claim 1 has been incorporated herein. Pinchen et al briefly mention RFID tag without further elaboration in [col 11: lines 5-12]. In the same field of endeavor, Klein further teaches: The method of claim 1, wherein at least one of the product item and the interface surface is associated with an RFID tag, and the determining step includes reading the RFID tag to determine the product identity data [p0014, p0017, p0020, p0021]. Using RFID tags for product identification has been well known and practiced in the art as prescribed by Pinchen et al and Klein. Therefore, it would have been an obvious variation for an ordinary skilled in the art to substitute RFID tag for Lubow's barcode for offering a better range and stronger signal for scanning operation.

Claim 32 (original) has been analyzed and rejected w/r to claim 3 in accordance with the rejection of claim 27.

Claim 34 (previously presented) has been analyzed and rejected w/r to claims 3 and 8 in accordance with the rejection of claim 27.

5. **Claims 20 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lubow et al (US Pub: US 2006/0118631), Pinchen et al (US Patent.: 7,188,774) and Kurokawa (US Patent: 5,625,467); and in further view of Endoh (Patent No.: 5,818,031).**

Regarding claim 20 (previously presented), the rationale applied to the rejection of claim 1 has been incorporated herein. Lubow et al teach redundant

barcodes in [p0042, lines 9-14]. However, Lubow et al, Pinchen et al, and Kurokawa do not teach encoding a bar code using Reed-Solomon code. In the same field of endeavor, Endoh teaches: The method of claim 1, wherein the coded data portions are encoded using Reed-Solomon encoding [col 2, lines 56-64]. Therefore, it would have been obvious to an ordinary skilled in the art to combine Lubow et al and Endoh's teaching to redundantly encode bar codes with Reed-Solomon code for improving the probability of reading the bar codes printed on mails as prescribed by Endoh.

Claim 41 (previous presented) has been analyzed and rejected w/r to claim 20 in accordance with the rejection of claim 27.

Conclusion

6. Applicant's amendment necessitated the new grounds of rejection presented in this Office Action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

Contact

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fan Zhang whose telephone number is (571) 270-3751. The examiner can normally be reached on Mon-Fri from 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark K. Zimmerman can be reached on (571) 272-7653. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Fan Zhang/

Patent Examiner

/Mark K Zimmerman/

Supervisory Patent Examiner, Art Unit 2625